



UNITED STATES PATENT AND TRADEMARK OFFICE

AK
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,518	03/16/2004	Donald J. Pinto	PH 7466 NP	3204
23914	7590	02/09/2006	EXAMINER	
LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			FREISTEIN, ANDREW B	
			ART UNIT	PAPER NUMBER
			1626	
DATE MAILED: 02/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Claims 1-21 are currently pending in the instant application.

Priority

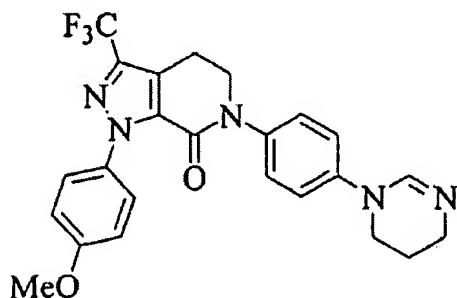
This application claims benefit from US Provisional Application No. 60/455,709, filed 03/18/2003.

Information Disclosure Statement

Applicant's information disclosure statements (IDS), filed on 10/04/2004 and 05/26/2004, have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Restriction Requirement

Applicant's election of Group I, claims 1-8 and 17-21, and the species



, in the reply filed on 12/08/2005 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

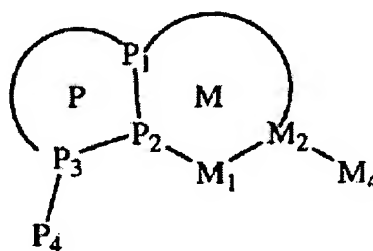
Art Unit: 1626

Claims 1-7 and 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is drawn to a compound of the formula (I), $P_4-P-M-M_4$, wherein M is a 3-10-membered carbocycle or a 4-10-membered heterocycle consisting of: carbon atoms and 1-3 heteroatoms selected from O, $S(O)_p$, N, and NZ^2 .

The definitions of P_4 , P, M and M_4 , are so broad that they are indefinite, unsearchable, and unclassifiable. There is no clear unambiguous claim to indicate how the variables are bonded to each other and what rings are in each compound. According to the STN search report, there are over 750,000 projected answers for this core structure and no proper search can be performed (see STN International, Columbus, OH, search performed 01/10/2006).

Similarly, claim 2-7 and 9-14 are indefinite for the same reasons as claim 1. For



example, claim 2 is drawn to a formula , wherein ring M, including P_1 , P_2 , M_1 and M_2 is a 5, 6, or 7 membered carbocycle or a 5, 6, or 7 membered heterocycle. Claim 3 is drawn to 105 different structures for variable M and 44 different structures for variable P. Thus all of claims 1-7 and 9-15 contain widely divergent variables, which creates unsearchable claims.

Art Unit: 1626

The claims are unclassifiable, because the variables P_4 , P, M and M_4 , do not indicate a specific ring. For example, compounds containing six-membered hetero rings having two or more heteroatoms of which at least one is N is classified in class 544; compounds containing six-membered hetero rings consisting of one N and five carbon atoms is classified in class 544; and five-membered hetero rings having at least one N atom are classified in class 548. Since the definitions of the variables P_4 , P, M and M_4 define rings of 3-10 members with 0-3 heteroatoms, no proper classification of the compounds of the instant application can be made.

Further, since no proper classification can be made, no prior art search of the class and subclass of claims 1-7 and 9-15 can be made. Therefore, the claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. See MPEP 903.07 and 904 (classification and search).

Status of the Claims

Claims 1-17 (in part) are withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 CFR § 1.142(b). The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference that anticipates one invention would not render obvious the other invention.

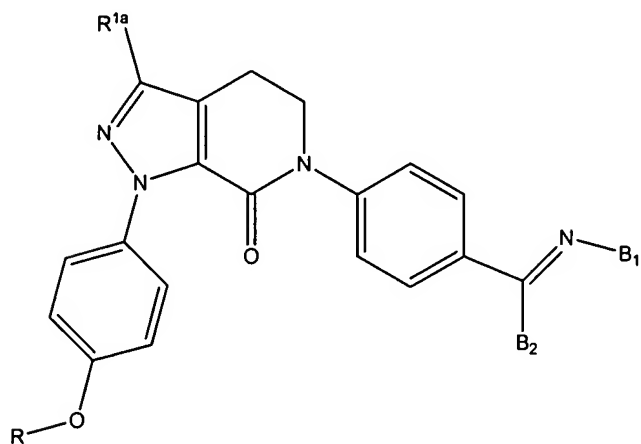
Elected and Examined Subject Matter

The scope of the invention of the elected subject matter and the examined subject matter is as follows:

The scope of the invention of the non-elected and non-examined subject matter is as follows:

Art Unit: 1626

All compounds of the Formula (I), P₄-P-M-M₄, that are not provided above and more specifically, compounds of the formula



B¹ and **B²** are as defined in claim 1.

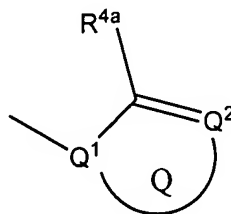
As a result of the election and the corresponding scope of the invention, identified supra, the remaining subject matter of Claims 1-17 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as thiazolidine, piperazine, quinoline, thiophene, morpholine, oxazol, pyran, etc. which are chemically recognized to differ in structure, function, and reactivity.

Therefore, the subject matter which was withdrawn from consideration as being non-elected subject matter materially differs in structure and composition from the elected/examined subject matter so that a reference which anticipates the elected/examined subject matter would not render obvious the non-elected subject matter.

Double Patenting

The Inventors of the instant application have many patents and copending applications with a similar core structure. However, Examiner finds no Double Patenting issues with respect to the scope of the elected invention as defined above.

The closest relevant art with respect to double patenting is US Pat. No. 6,750,225. This patent differs from the instant application because the instant



application claims the variable "B" to represent: , which is a heterocycle with at least one N atom and one double bond in the ring. However, US Pat. No. 6,750,225 claims a compound with pyridine or imidazole, which are Nitrogen-containing heterocycles with two and three double bonds respectively. Thus, the patent claims different compounds.

Closest Relevant Art

The closest relevant art is Fevig et al. (WO 00/39131), which would be considered prior art under 35 USC 102(b) of non-elected subject matter.

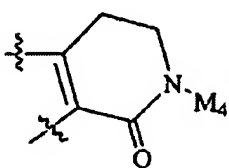
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

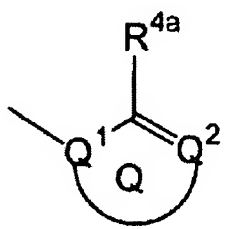
A person shall be entitled to a patent unless –

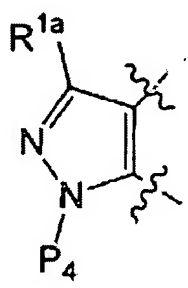
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

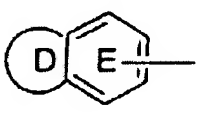
Art Unit: 1626

Claims 1-3 of the instant application are drawn to a compound of formula I, P₄-P-

M-M₄, wherein M is ; M₄ is Z-A-B; Z is a bond; A is C₆-carbocycle,

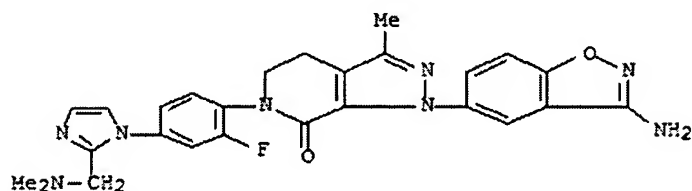
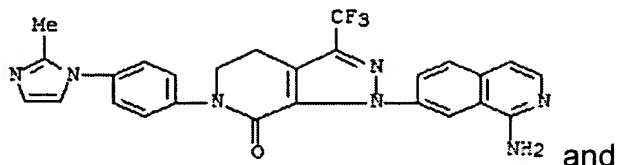
substituted with 0-2 R⁴; R⁴ is F; B is ; Q¹ and Q² are each N; Q is a 5-membered heterocycle; R^{4a} is C₁alkyl or (CR³R^{3a})_rNR²R^{2a}; R³ and R^{3a} are H; r is 1; and

R² and R^{2a} are each C₁alkyl; P is ; R^{1a} is (CR³R^{3a})_rR^{1b}; r is 0; R^{1b} is

(CF₂)_rCF₃; r is 0; P₄ is G₁-G; G₁ is absent; G is Formula IIa, ; E is phenyl; D is a six-membered heterocyclic ring consisting of carbon atoms, and 0-2 heteroatoms selected from N and O, which is substituted with R; and R is NH₂.

Claim 17 is drawn to a pharmaceutical composition comprising a therapeutically effective amount of a compound of Formula (I) and a pharmaceutically acceptable carrier.

Fevig et al. disclose the compounds:



(see Fevig, et al, STN International

(2006) HCAPLUS Database, Columbus, OH, Accession No. 2000:457072, Reg. Nos. 280119-13-3 and 280119-14-4).

Fevig et al. disclose pharmaceutical compositions comprising the compounds disclosed (see US 6,413,980, col. 216, line 54 – col. 220, line 22).

Claim Objections

Claims 1-17 are objected to as containing non-elected subject matter.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew B. Freistein whose telephone number is (571) 272-8515. The examiner can normally be reached Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^cKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

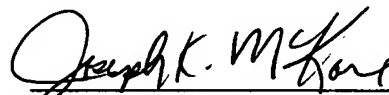
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1626

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Andrew B. Freistein
Patent Examiner, AU 1626



Joseph K. McKane
Supervisory Patent Examiner, AU 1626
Date: February 3, 2006